



4 of 4
15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

CETIN KAYA

Serial No. 09/620,649 (TI-23686.1)

Filed July 20, 2000

For: INTEGRATED CIRCUIT HAVING INDEPENDENTLY FORMED
ARRAY AND PERIPHERAL ISOLATIO DIELECTRICS

Art Unit 2822

Examiner M. Wilczewski

Director of the United States
Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**REQUEST FOR REHEARING AND
RECONSIDERATION UNDER 37 C.F.R.1.197(b)**

Request is hereby made for reconsideration and rehearing of the appeal in the subject application.

Subsequent to filing of the Brief on Appeal and the Reply Brief in the subject appeal, counsel for appellant became aware of the decision by the United States Supreme Court in Pfaff v Wells Electronics, 525 U.S. 55, 48 U.S.P.Q2d 1641 (U.S. 1998) wherein the meaning of the term "invention" was specifically defined as it applies to 35 U.S.C.

It is clear from reading 35 U.S.C. that the word "invention" in the statute "does not contain any express requirement that an invention must be reduced to practice" as

stated in Pfaff and even in section 102(g) where the conception and reduction to practice are specifically mentioned, there is no requirement that these be the only factors considered. It follows, first, that 35 U.S.C. nowhere define “invention” by a determination solely of the questions of reduction to practice or conception with diligence up to a reduction to practice (actual or constructive). While a proper showing of a reduction to practice or conception with diligence up to a reduction to practice does establish invention under 35 U.S.C, there is nothing in 35 U.S.C. which limits the definition of invention to only those factors. This is confirmed in Pfaff wherein the Court rejected the longstanding precedent set forth above by stating [III] “Pfaff nevertheless argues that longstanding precedent buttressed by the strong interest in providing inventors with a clear standard identifying the onset of the 1-year period, justifies a special interpretation of the word ‘invention’ as used in § 102(b). We are persuaded that this nontextual argument should be rejected.”

As stated in the opinion in defining the term “invention”, the Court states that “Thus petitioner’s argument calls into question the standard applied by the Court of Appeals, but it does not persuade us that it is necessary to engraft a reduction to practice element into the meaning of the term ‘invention’ as used in § 102(b).

The Court further states:

“The word ‘invention’ must refer to a concept that is complete, rather than merely one that is ‘substantially complete.’ It is true that reduction to practice ordinarily provides the best evidence that an invention is complete. But just because reduction to practice is sufficient evidence of completion, it does not follow that proof of reduction to practice is necessary in every case. Indeed, both

the facts of the Telephone Cases and the facts of this case demonstrate that one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice.”

The Court concluded that the on-sale bar applies when two conditions are satisfied, the first condition not being applicable in this case because it relates to conditions of sale. However, the second condition relates to the definition of “invention” and states:

“Second, the invention must be ready for patenting. That condition may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawing or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention. In this case the second condition of the on-sale bar is satisfied because the drawing Pfaff sent to the manufacturer before the critical date fully disclosed the invention: (underline not in original)

It follows that there is an invention disclosure is provided which contains “prepared drawing or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention”.

In the present appeal, the specification in the provisional application Serial No. 60/060,561 is substantially identical to the specification in the subject application on appeal. There has never been any question of sufficiency of disclosure of the claimed invention in the prosecution of the subject application. It follows that the subject application contains a disclosure which is ready for patenting as defined by the Supreme

Court in Pfaff and that appellant is entitled to rely at least upon the filing date of his provisional application (and possibly an earlier date if it can be established).

In view of the above argument, rehearing and reconsideration are requested since the Van Buskirk et al. reference is not available under 35 U.S.C.102(e).

Respectfully submitted,

Jay M. Cantor
Reg. No. 19906
Phone (301) 424-0355
Phone (972) 917-5293
Fax (301) 279-0038